



08 OCT 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

KENYON & KENYON
One Broadway
New York, New York 10004

In re Application of	:	
LENZING, Thomas, et al.	:	
U.S. Application No.: 10/088,841	:	COMMUNICATION
PCT No.: PCT/DE01/02669	:	REGARDING SUBMISSION
International Filing Date: 17 July 2001	:	UNDER 37 CFR 1.42
Priority Date: 21 July 2000	:	
Attorney's Docket No.:10191/2313	:	
For: DEVICE FOR DETERMINING AT LEAST ONE	:	
PARAMETER OF A FLOWING MEDIUM	:	

This communication is issued in response to applicant's submission on 01 July 2002 of a declaration executed on behalf of the deceased inventor, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 17 July 2001, applicants filed international application PCT/DE01/02669 which claimed a priority date of 21 July 2000 and which designated the United States. On 31 January 2002, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

A Demand was not filed with the International Preliminary Examining Authority electing the United States prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was twenty months from the priority date, i.e., 21 March 2002.

On 21 March 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 30 May 2002, the USPTO mailed a Notification Of Missing Requirements indicating that an executed oath or declaration in compliance with 37 CFR 1.497 and the \$130 surcharge for filing the declaration later than twenty months after the priority date were required.

On 01 July 2002, applicants filed a response to the Notification Of Missing Requirements which included payment of the surcharge and a declaration executed by the surviving co-inventors and, apparently, by someone on behalf of the deceased co-inventor Dieter TANK.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

37 CFR 1.497(b)(2) requires that citizenship, mailing address, and residence information be provided for **both** the deceased inventor and the legal representative. The regulation expressly requires the inclusion of this information for the legal representative. As for the deceased inventor, such information is required because the legal representative must declare to all the facts which the inventor would have been required to state, and citizenship, residence and mailing address are among the facts which the inventor would have been required to set forth pursuant to 37 CFR 1.497(a) and 37 CFR 1.63.

Applicants have submitted supplemental materials with respect to the deceased inventor's estate, but these materials do not make clear whether Anke FLEISCHER is the sole heir of the deceased inventor with respect to this patent application. While applicants have submitted a translation of a "Certificate Of Inheritance" naming Anke FLEISCHER as the sole heir, the attached materials imply that the deceased inventor's parents also have an interest in the deceased inventor's estate. If this is the case, then these additional heirs must also execute the declaration (under 37 CFR 1.42, the signature of all the heirs of a deceased inventor are required, if there is no legal representative and applicable law does not require the appointment of a legal representative). Applicants should note that the submission of a declaration executed by the heirs of the deceased inventor is construed as an indication that no legal representative of the deceased's estate has been appointed or is required by the applicable law to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to

submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

Moreover, even if the filed declaration was executed by the proper party under 37 CFR 1.42, the declaration does not comply with 37 CFR 1.497(b)(2) in that it does not expressly state who is executing the declaration on behalf of the deceased inventor or the "relationship of the person to the inventor (i.e., "[name] as the sole heir of deceased inventor Dieter TANK"). The declaration also does not include the citizenship, mailing address, and residence information for both the heir and deceased inventor, as required. From the supplemental materials, it appears that the information might be the same for the heir and the deceased inventor, but this information is required in the declaration itself.

Because the declaration does not expressly state the name of the person signing the declaration on behalf of the deceased inventor and the relationship of this person to the inventor, and because it does not provide all the information required by 37 CFR 1.497(b)(2), the present declaration is unacceptable, even if applicants can demonstrate that it was executed by the proper party under 37 CFR 1.42.

CONCLUSION

The 01 July 2002 submission under 37 CFR 1.42 is **REFUSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment. A proper response must include an acceptable declaration properly executed under 37 CFR 1.42 and 37 CFR 1.497 with a showing that the person(s) executing on behalf of the deceased inventor are either the inventor's legal representative(s) or all of his heirs, as discussed above.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459